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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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24011	7590	02/04/2011		
SILVERBROOK RESEARCH PTY LTD 393 DARLING STREET BALMAIN, 2041 AUSTRALIA			EXAMINER UBER, NATHAN C	
			ART UNIT 3622	PAPER NUMBER
			NOTIFICATION DATE 02/04/2011	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/815,642

Applicant(s)

SILVERBROOK ET AL.

Examiner

NATHAN C. UBER

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 November 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 10, 12 and 29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 10, 12 and 29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-848)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of Claims

1. This action is in reply to the amendments filed on 22 November 2010.
2. Claims 1 is amended.
3. Claims 1, 2, 10, 12 and 29 are currently pending and have been examined.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Claim 1 newly claims "sending the serial number of the coupon to the administration server" however; there is no support for this limitation in the original disclosure. By adding this limitation now, Applicant introduces subject matter into the claims that was not part of the original disclosure. Therefore the newly added limitation in amended claim 1 is considered impermissible new matter and must be removed from the claim.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious

Art Unit: 3622

at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
8. Claims 1, 2, 10, 12 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murphy et al. (4,554,446) in view of Lazzouni et al. (U.S. 5,661,506) and in view of Dymetman et al. (U.S. 6,330,976 B1).

Claims 1, 2 and 29:

Murphy discloses an inventory control method that uses a combination of machine readable and human readable indicia on product labels and coupons to track inventory, manage pricing, and conduct various incentive promotions electronically using a combination of point of sale machines and computers. (See at least Figures 1 and 2, see also column 4, lines 27-32). Product identification is discussed with reference to the UPC code (see at least column 3, lines 60-66), however Murphy also more broadly discloses bar codes which may be used to identify more than just UPC data and anticipates or at least renders obvious Applicant's added limitation of *uniquely* identifying the "product item." Murphy particularly notes several different types of coupons including coupons disposed on the product itself as well as coupons that require the customer to transmit customer identification data to the product manufacturer. Murphy points out that in situations where coupons require interaction from the customer, many customers cannot be bothered (a sentiment echoed in applicant's specification), so Murphy solved this problem by creating coded forms and ID cards so that the customer can simply transmit requisite personal information electronically by swiping or entering their coded

information. The coupon redemption methods are discussed broadly in columns 9 and 10. Lines 9/18-29, 9/48-61 and 10/22-46 are particularly relevant to applicant's claims directed towards transmission of coupon and customer information as well as submitting electronic forms. The Murphy disclosure explains that coupon fulfillment information is stored by the system, so that when a coupon is recognized by the system, the system can verify whether the stored coupon conditions are met before issuing the benefit (see at least column 10, lines 52-63 and column 11, lines 46-52). With regard to verifying a purchase by accessing a database, Murphy also discloses a verification procedure that relies on stored data to handle lost or destroyed documents. The Murphy system only records sales and voucher redemptions at the time of purchase and redemption. Therefore, if a customer claims later to have lost a voucher, the system can enter a replacement voucher for the customer. The system will quickly verify that the voucher was not already redeemed by accessing the stored information at the host computer (see at least columns 11-12, lines 64-67 and 1-2). Murphy also discloses a 'scan coupon concentrator' which is a data storage device that stores all of the compliance requirements for a given coupon/voucher, such compliance information often includes a verification of purchase of a particular item (see at least column 10, lines 52-63). Murphy also discloses storing purchase data and redemption data (see at least column 8, lines 1-7). With regard to printing when a purchase is verified, the broadest reasonable interpretation of the claim includes the interpretation that the verification condition is not in the "affirmative." In other words the broadest reasonable interpretation of claim 1 does not include printing the coupon because that step only occurs when the verification is affirmative. Accordingly the "printing" step does not effect the scope of the claim because it does not occur. Further see column 9, lines 19-67, the self-liquidating premium (an offer that requires a customer to first make a purchase before it may be redeemed) is simplified by Murphy by allowing the coupon to be printed, the purchase verified and the premium ordered/satisfied.

Further with respect to the limitations of claim 1 directed to sensing machine readable code, position data and redemption information, Murphy discloses at least two sensing steps (swipe and scan) as well as receiving and transmitting redemption information as previously discussed. Further the barcode scanning of Murphy inherently requires the generation of position data as this is the basis for successful bar code scanning. The sensing device must identify the position of the registration posts on the bar code before it can interpret the code residing between the posts. Additionally the position of the bar code itself is inherently valuable to the sensing and data gathering step, especially for products or barcode sheets that may have multiple bar codes. However, Murphy does not specifically disclose the narrower interpretation of *interaction data* as may be gleaned from the specification. Lazzouni, in at least column 4, lines 16-17, 25-26, 34-38, 46-50, 57-59 and in Figure 1 discloses generating interaction data based on sensing the position of a scanning device on substrate that is coded with infrared machine readable coordinate code. Similarly Dymetman, in at least column 8, lines 14-23 a physical page and a digital page isomorphism, wherein the position and information on the physical page may have meaning and be recorded or transmitted as claimed (see also column 14, lines 16-31, discussing a range of position and other data that can be encoded onto the physical page to reading by the pointer/scanner device). It would have been obvious to one having ordinary skill in the art at the time of the invention to enhance the Murphy invention by integrating additional coded data into printed labels and coupons as taught by Lazzouni and Dymetman since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Claims 10 and 12:

Murphy does not disclose the limitations of claims 10 and 12. However, Lazzouni in at least in at least column 4, lines 16-17, 25-26, 34-38, 46-50, 57-59 and in Figure 1

discloses generating interaction data based on sensing the position of a scanning device on coded substrate. The *interaction data* includes a digital representation of writing (see at least Figure 1) and movement data (see at least column 4, lines 46-50).

Claims 10, 12 and 29:

With respect to the limitation of claims 10, 12 and 29, *the coded data further comprises position data identifying a position of the sensing device relative to the coupon*, the cited combination Murphy/Lazzouni discloses this limitation as shown above. The Lazzouni reference discloses a coded surface that is capable of generating interaction data representative of the position of the sensing device relative to the coded surface. Murphy discloses placing coupons on surfaces and using codes printed on surfaces to represent coupons. The combination of the references embraces identifying the location of the sensing device relative to anything printed on the coded surface.

Response to Arguments

9. Applicant's arguments filed 17 March 2010 have been fully considered but they are not persuasive. Applicant first argues with respect to the 112 first paragraph rejection that lines 4-12 of page 32 of the specification provide adequate support for the claim limitation "sending the serial number of the coupon to the administration server" because "one of ordinary skill in the art would be unable to attribute any other meaning the coupon number, other than that is a shortened version of coupon serial number" (see page 4 of Applicant's remarks). Examiner disagrees. First, Applicant implies that the specification discloses "coupon serial number" then later refers back to the same limitation as "coupon number." This is not the case. In line 5 of page 32 the specification reveals that a coupon is printed with "a serial number." There is no teaching that this is a "coupon serial number." Later on the same page, line 12 discloses that the "Hyperlabel server sends the retailer details, competition ID, competition alias ID and coupon number to the manufacturer server." "Coupon number" does not appear to be a shortened version of "serial number" nor does it appear to be related to a serial number in the specification. It is not even clear whether the "serial number" of line 5 is a coupon serial

number; it may be the serial number of the product that caused the coupon to be printed. Second, the claim limitation indicates that the serial number is sent "to the administration server;" however, the cited sections of the specification supports neither sending the serial number nor the coupon number to the administration server. Rather line 12 indicates that the Hyperlabel server (which Examiner interprets to be the administration server because it appears all of the relevant servers transmit and receive data from the Hyperlabel server) sends the coupon number to the manufacturer server. Thus the administration server is sending the coupon number to a manufacturer server. Finally Applicant argues that one having ordinary skill in the art would be "unable to attribute any other meaning the coupon number." Examiner disagrees. A serial number is a number that uniquely identifies an item that is otherwise indistinguishable; i.e. 1 item from a series of many of the same items. A coupon may have its own serial number, but it may have additional numbers as well. Coupons often are coded with numbers such as UPC numbers or a number that reveals the stored coupon details (i.e. the deal, the offer, redemption information, etcetera). It is not necessary that all coupons have serial numbers. Further one having ordinary skill in the art would be able to attribute many possibly meanings to "coupon number" and in fact would have difficulty attributing "serial number" to "coupon number" especially after reading the specification because Applicant specifically used different language to refer to the two distinct numbers. It would be hard for one of ordinary skill in the art to understand why Applicant specifically disclosed a step involving a "coupon number" if Applicant indented the steps to involve a "serial number" especially when Applicant specifically disclosed that a "serial number" is printed on the coupon. Because one having ordinary skill in the art would know that there are many numbers that may be associated with coupons, one having ordinary skill in the art would be lead by the teaching of the specification to assume that the serial number printed on the coupon was not the same as the coupon number involved in the sending step. Accordingly the rejection is maintained.

10. Applicant next argues that "Murphy provides no motivation to modify the UPC barcode disclosed therein to encode a unique identity of the product item... [T]here mere fact that the prior art includes position coding does not suggest one of ordinary skill in the art would be motivated to replace the barcodes of Murphy with the codes of Lazzouni or Dymetman" (see page 4 of Applicant's remarks).

Art Unit: 3622

Applicant's argument is not persuasive because it assumes that no combination of prior art would render Applicant's invention obvious unless Murphy discloses some motivation for modifying its own disclosure. The "teaching suggestion motivation" (TSM) approach to an obviousness rejection is not the exclusive means for justification of an obviousness rejection. Further even under the TSM approach the motivation may be found in any of the references. Here Dymetman for example specifically discloses applying the coded location data technique to any "marketing medium" and coupons and product packaging are both well known marketing mediums. Applicant's claimed invention simply employs known technology (and Applicant admits that "the prior art includes position coding") to a known method of issuing, authenticating and redeeming coupons for product discounts. The combination of the prior art teachings obvious, as indicated in the rejection above, because the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable. Whether or not Murphy discloses some additional motivation is irrelevant.

11. Next Applicant argues that Murphy provides "no reason for uniquely identifying the product item"

Applicant suggests that the product identification in Murphy is for a different purpose and cannot be equated to "specifying a unique product item." As noted in the rejection above, the limitations are all taught by the prior art. It may be possible that a prior art reference discloses a different reason for performing a step, but the prior art nevertheless teaches the same step and the scope of the claim is limited to the steps performed... not the reasons the steps are performed. Applicant argues that the claimed invention is distinguishable from the prior art because a purchase can be verified "at any time after purchase" Applicant then goes on to argue that Murphy is limited to verifying purchase at the time of purchase. However Applicant's claims do not indicate when purchase verification occurs. Further verifying a product purchase at any time after a purchase, if added to the claims, would not lead to an allowable invention as product registration, receipts and a myriad of approaches existed before Applicant's invention all with the express purpose of verifying a legitimate product purchase at any time after the purchase. Finally in crafting this argument Applicant appears to have missed the

Art Unit: 3622

several teachings in Murphy in which Murphy discloses tracking an inventory of coded coupons as well as a verification procedure that tracks when coupons are redeemed. Murphy suggests for example that if a coupon or redemption voucher is lost, the system can quickly verify if a customer is entitled to the coupon/voucher and whether it was ever redeemed (see columns 9-12 or the rejection above). Since Murphy describes initially presenting the coupon/redemption voucher at the time of the purchase of the qualifying item, Examiner assumes that verifying entitlement/redemption of the coupon/voucher to account for lost coupons would at least be necessary some time after the purchase of the qualifying product.

12. In Applicant's final argument Applicant argues that the new limitation "the coupon is printed upon the verifying step being in the affirmative" overcomes Murphy because in "Murphy the coupon is obtained through means unrelated to the purchase" (see page 5 of Applicant's remarks). Examiner disagrees. Presently claim 1 presents a condition and the printing step only occurs when a particular result of the condition occurs. The broadest reasonable interpretation of the claim however includes the interpretation that the condition is not in the "affirmative." In other words the broadest reasonable interpretation of claim 1 does not include printing the coupon because that step only occurs when the verification is affirmative. Accordingly the "printing" step does not effect the scope of the claim because it does not occur. Further see column 9, lines 19-67, the self-liquidating premium (an offer that requires a customer to first make a purchase before it may be redeemed) is simplified by Murphy by allowing the coupon to be printed, the purchase verified and the premium ordered/satisfied.
13. Accordingly the claims remain unpatentable over the prior art because they fail to disclose a novel or non-obvious distinction over the prior art.

Conclusion

- 14. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
- 15.** A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

16. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **Nathan C Uber** whose telephone number is **571.270.3923**. The Examiner can normally be reached on Monday-Friday, 8:30am-4:00pm EST. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **Eric Stamber** can be reached at **571.272.6724**.
17. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> <<http://pair-direct.uspto.gov>>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).
18. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

P.O. Box 1450, Alexandria, VA 22313-1450

or faxed to **571-273-8300**.

19. Hand delivered responses should be brought to the **United States Patent and Trademark Office Customer Service Window**:

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401 Dulany Street
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/Nathan C Uber/ Examiner, Art Unit 3622
31 January 2011

/Arthur Duran/
Primary Examiner, Art Unit 3622